

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on JAN 20 2007

Signature

KHAI HEE KWANTyped or printed
name

Application Number

09-396005

Filed

SEPT 13-1999

First Named Inventor

KHAI HEE KWAN

Art Unit

3621

Examiner

JAMES A REAGAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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60-89-218853

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JAN 20 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required; see below.

*Total of 6 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: James A Reagan

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

The Prior Arts

The examiner used Rosen (US 5455407) and Jennings (US 5659165)

- 5 Rosen is a system to transfer funds between electronic modules which requires interactivity between payer and payee. Funds are electronic ‘token’ which is claimable from banking institutions where the original deposits was drawn/downloaded from payer’s bank account.
- 10 Jennings is a system to transfer funds from one bank account to another within the same system. It does not involve any interactivity with the payee and depends on a centralization system whereby funds from one account to another ‘moved’ by book entry rather than a transmittable token system as in Rosen.

15

Our claimed Invention

- The main independent claims are 13,34,39 (different classes) which 13 can be a representative. In addition claims 48 and 49 (different classes)
- 20 wherein Claim 48 can be a representative.

- The broadest claim is claim 48 which provides a method where two persons can instantaneous transfer funds to each other. The claimed invention uses funds drawn from sources having identifier that is
- 25 different to the payer’s identifier. For example if the payer’s self-created identifier is Mr BIGMAN or 787239749, then the source identifier cannot be either. In other words the identifier of the source of funds must be different to payer’s created identifier and the depositing of these funds is without using the payer’s bank account. This element of “without using
- 30 the payer’s bank account” is most critical as both prior arts Rosen and Jennings uses funds that are deposited USING a bank account. Furthermore, the transfer is without interacting with payee and source of funds (which means Rosen is not applicable as Rosen requires a module to transfer tokens between users, Jennings is not applicable either as it
- 35 interact with source of funds – bank account).

Application number: 09/396005

Art Unit: 3621

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Claim 13, is limited to the source of funds being prepaid cards and the transfer to payee must be made independently of said prepaid cards and without interacting with payee. The other elements of claim 13 refers to checking for authority and amount and administratively recording the transfer. None of the prior arts show prepaid funds and it is obvious funds in bank accounts are not prepaid.

Advisory Action Letter.

- 10 In Advisory Action mailed 12/05/2006, the examiner avers that prior art of record is clearly and unarguably analogous as well as relevant. The examiner continued by placing on record that the combination of prior arts “wholly and flawlessly” discloses the claimed invention.
- 15 The applicant in submitting this Preliminary Appeal begs to differ and will show that there is no teaching to combine and the combination of both prior arts do not wholly and flawlessly discloses the claimed invention.
- 20 Firstly, it is pertinent to note that the examiner’s final rejection letter (mailed 11/02/2006) at page 9 fails to show that the examiner had incorporated the amendments made in the previous submission mailed 20 August 2006. In fact, the 103(a) rejection for claims 13,34,39 from page 8 to 9 is the same (word by word) from Action Letter mailed
- 25 5/18/2006 (at page 4 & 5) which clearly indicates prima facie the examiner did not consider the amendments or the examiner failed to reflect this in the Action Letter.

30 The missing elements from claim 13 (as representative of 34,39) that are missing are shown below:

whereby said stored fund is deposited from a prepaid card; and

whereby said transfer is made without interacting with said payee and independently of said prepaid card.

It is clear that Jennings and Rosen have no teachings for stored funds deposited from prepaid cards and where said transfer is made independently of said prepaid card. The examiner made no mention of this at page 4 & 5. Even if Rosen teaches modules which arguable is a kind of “electronic” card (which is denied since deposits downloaded from payer’s account is NOT prepaid), the problem is that Rosen fails to teach transferring funds independently of said card. Perhaps it is more accurate to call Rosen’s module as deposit cards (ie smart cards) with stored tokens but not as a prepaid since account holder cannot prepay for using his own money from deposit account.

In fact, Rosen is wholly dependent on the modules to effect transfer as funds (tokens) are electronically stored in said modules and not as in our claimed invention at a remote server.

While Jennings teaches transfer of funds between bank accounts, this is not the same as teaching transferring funds deposited from prepaid cards and independently of said cards. (See US Patent 6473500 by Risafi particularly Fig 10C which clearly show using a second card intended for payee to receive funds)

With respect, the examiner seems to have equated funds/accounts to be same whether they are debit or prepaid or credit etc which is evident from the prosecution history of this application. This by itself is a major setback given it is well known that each type of facility (credit/debit/prepaid) requires different systems and are not equal. To appreciate the difference one need only need to see the difference between using a credit card and a debit card, the latter deducting funds immediately from one’s account. A prepaid card is a different breed because it is neither a debit nor a credit card but one that is designed for specific paid services like telecommunication or specific vendor.

Motivation.

5 So the fact that Jennings teaches transferring funds from a bank account to another, does not by itself reveal any suggestion to one skilled in the art to combine with transferring tokens using modules to reveal a prepaid card instead and making the transfer without using said cards as claimed (see claim 13).

10

There is a gap unexplained to show why the two competing technology are positioning to combine; for example Rosen's module works without an intermediary (outside the system) while Jennings clearly depends on the banking system by using bank accounts as its source of funds. The
15 examiner provided Rosen Col 2 lines 42-49 as the motivation factor which clearly also says "without the mediation of a banking system" putting it straight into the warpath of Jennings's. It is also noted that Rosen (supra-last sentence) considers limitations in the current EFT system which clearly denotes his dissatisfaction for the banking system.

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It is respectfully submitted, there is no method to combine using modules (which requires interacting between payer and payee as in Rosen) with using bank accounts (which do not require interacting with payee as per Jennings). If bank accounts are chosen, then obviously
25 modules cannot be used as source of funds for transfer and vice-versa which highlight the impossibility of such combination.

Furthermore, no reliance was place to show Jennings' invention which uses bank accounts could work without the mediation of a banking
30 system such that it could combine with Rosen.

And even if it could be done (which is denied) there is still no motivation to modify a bank account (in Jennings) including a deposit/saving account (in Rosen) into a prepaid card capable of depositing funds into
35 payer's account having different identifier (as per claim 48). As

mentioned, the fact that deposits are downloaded as tokens to a module does not by itself make it prepaid.

5 What motivation is there to explain using a prepaid card to deposit funds in lieu of using a deposit/saving account to download funds/tokens to a module (Rosen) or simply using a bank account (saving or debit or credit) to transfer funds as in Jennings ? Even if it is well known that prepaid cards provide anonymity (which is not found in Jennings nor Rosen), there is no teaching to use these anonymous funds by depositing them
10 into a self-created account facilitating fund transfer and wherein such transfer is independent of said prepaid cards.

Subject matter as a whole not obvious at time of claimed invention.

15 It is clear that claim 48/49 refers to a webcentric-based person to person fund transfer without using a bank account as opposed to one using a module to module (Rosen) or bank account to bank account (Jennings). In US Patent 7031939 (Filed August 15, 2000) by Gallagher which deals with a person to person payment using email identifiers (like paypal but
20 requiring interacting with payee-claim1), all the cited references post-dates this application. In US Patent 6473500 (Filed Oct 28, 1998) by Risafi, the invention deals with a prepaid card and requires interacting with such a card for transaction as opposed to our Claimed invention which is independent of such card or source of funds. It is noted that in
25 US Patent 6,805,289 (Filed May 23, 2002) by Noreiga, the reason for allowance was given as being a difference between ACH and a centralised server which pays on-behalf of card issuers (See page 6 of Notice of Allowance for Application 10/153/575) which is submitted to be narrower as compared to Claim 48/49. The examiner in Noreiga also
30 knew the earliest known prepaid VISA known in August 2001 which is 2 years post this application (See Page 2 of Action Letter mailed 05/01/2004). However, even in Noreiga, the user is using the prepaid card as the means of transfer (claim 6). Therefore, the evidence above are clear and collectively, the subject matter as a whole is not obvious.